

Certificate of Mailing Under C.F.R. §1.8

I hereby certify that this correspondence and all marked attachments are being deposited by Express Mail, Express Mailing Label No.: EL 989434393 US on April 7, 2004 addressed to: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: Al. Pule Abigail Rivamonte

**IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE
REQUEST FOR FILING
(RULE 53(b)(1))**

For Design or Utility Applications

Rule 53(b)(1) PATENT APPLICATION:

☒ Continuation)
) application under 37 CFR 1.53(b)(1)
☐ Divisional)
) application under 37 CFR 1.53(b)(1)
) of pending prior application of

Group Art Unit: Not yet assignedExaminer: Not yet assignedInventor(s): Pantoliano et al.Parent Appln. No.: 09 801,676

Series Code ↑

Serial No. ↑

Atty. Dkt. 044988-0308977New C-M

Client Ref

Parent Filed: March 9, 2001This Appln. Filed: April 7, 2004

Title: Microplate Thermal Shift Assay Apparatus For Ligand Development And Multi-Variable Protein Chemistry Optimization

Mail Stop Patent Application
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Date: April 7, 2004
(Parent Matter No. 044988-0304593)

Sir:

To effect the above-requested filing today:

1. Attached is a copy (which must be filed) of the prior application, including:

- ☒ Abstract
☒ Specification and claims (109 pages) (must be attached)
☒ Drawings (must be attached if originally filed): 42 sheet(s)/set: ☒ 1 set informal;
☐ Formal of size ☐ A4 ☐ 11"

1A. Always X one box, only:

- (1) ☒ Copy of Signed declaration or oath as originally filed in prior application no. 08/853,459 is attached
(2) ☐ NO declaration or fee is enclosed; therefore, this is a filing under Rule 53(f).

2. THE INVENTOR(S) FOR THIS NEW APPLICATION IS(ARE):

1. PANTOLIANO, Michael
3. RHIND, Alexander W.
5. _____
7. _____

2. BONE, Roger F.
4. SALEMME, Francis R.
6. _____
8. _____

3. The entire disclosure of the prior application is considered as being part of the disclosure of the accompanying application and is hereby incorporated therein by reference thereto.

4. ☐ Priority is claimed under 35 U.S.C. 119/365 based on filing in _____ of _____ (country)
- | | <u>Application No.</u> | <u>Filing Date</u> | | <u>Application No.</u> | <u>Filing Date</u> |
|-----|------------------------|--------------------|-----|------------------------|--------------------|
| (1) | _____ | _____ | (2) | _____ | _____ |
| (3) | _____ | _____ | (4) | _____ | _____ |
| (5) | _____ | _____ | (6) | _____ | _____ |

a. ☐ _____ (No.) Certified copy/copies attached.

b. ☐ Certified copy/copies previously filed on _____ in _____
U.S. Application No. _____ / _____, filed on _____
series code \uparrow \uparrow serial no.

c. ☐ Certified copy/copies filed during International stage of PCT/ _____ / _____

4. (a) ☐ Domestic priority is claimed from PCT/ _____ / _____, filed _____.
- (b) ☐ Benefit is claimed of Provisional Application No. 60/_____, filed _____.

5. ☐ Prior application is assigned to _____
by assignment recorded _____ Reel _____ Frame _____
(Date)

6. ☐ Attached is the following number of Assignments (including original and all later successive ones by different assignors): _____ and respective **new** Cover Sheets. (Do **NOT** file old cover sheets.)

(Assignments in parent **must be refiled** with new Cover Sheets in this continuing application if you want it/them recorded against the continuing application.)

Please return the recorded Assignment to the undersigned.

7. ☒ The power of attorney in the prior application is to: _____
Vicki G. Norton (Reg. No. 40,745) and Aubrey A. Haddach (Reg. No. 48,374)

whose current address is as in item 8 below.

- a. ☐ Recognize as associate attorney _____
(Name, Reg. No. and Address)

8. **Address all future communications to Intellectual Property Group of Pillsbury Winthrop LLP, 11682 El Camino Real, San Diego, CA 92130-2593**

9. This application claims benefit of the following prior US application(s), the contents of which are incorporated into this application by this reference:

| | |
|-----------------------|--------------------------------|
| No. <u>09/801,676</u> | filed <u>March 9, 2001</u> |
| No. <u>09/459,996</u> | filed <u>December 14, 1999</u> |
| No. <u>08/853,459</u> | filed <u>May 9, 1997</u> |
| No. <u>60/017,860</u> | filed <u>May 9, 1996</u> |

- 9(a). ☒ See the attached Preliminary Amendment, which amends the first page of the specification to claim benefit of the above listed US application(s)

10. **Small Entity Status** ☒ is Not claimed ☐ is claimed **(pre-filing confirmation required)**

11. Petition to extend the life of the above prior application to at least the date hereof
☐ is being concurrently filed in that prior application (Use Form PAT-111).
☐ was previously filed in that prior application (Check length of prior extension).
☒ is not necessary for copendency.

12. ☒ **INFORMATION DISCLOSURE STATEMENT:** Attached is an Information Disclosure Statement and Form PTO-1449 listing all of the documents cited by Applicant and the PTO in the parent application(s) relied upon under 35 USC 120 and referenced in item 9 above. Per Rule 98(d) copies of those documents are not required now. Please consider those documents and advise that they have been considered in this new application as by returning a copy of the enclosed Form PTO-1449 with the Examiner's initials in the left column per MPEP 609.
13. ☐ Attached is a Rule 103(a) Petition to Suspend Action.
14. ☒ **Please see** the attached Preliminary Amendment which reduces the number of claims for purposes of reducing the initial filing fee.

FILING FEE

THE FOLLOWING FILING FEE IS BASED ON

-->-->-->CLAIMS AS FILED AND CHANGED BY PRELIMINARY AMENDMENT IN ITEM 14<--<--<--<

NOTE: If box 1A2 is X'd, do not pay fees,
but leave lines 15-22 and 27-32 blank.

PTO: PLEASE NOTE CLAIM CANCELLATIONS IF BOX 14 ABOVE IS X'D.

| | | | | Large/Small Entity | | Fee Code |
|---|----|------------|---|-----------------------|---------------|-------------|
| 15. Basic Filing Fee Design Application | | | | \$340/\$170 | | 1002/2002 |
| 16. Basic Filing Fee Utility Application | | | | \$770/\$385 | +770.00 | 1001/2001 |
| 17. Total Effective Claims | 10 | minus 20 = | 0 | x \$18/\$9 | +0 | 1202/2202 |
| 18. Independent Claims | 3 | minus 3 = | 0 | x \$86/\$43 | +0 | 1201/2201 |
| 19. If <u>any proper</u> multiple dependent claim (ignore improper) is present, | | | | \$290/\$145 | +0 | 1203/2203 |
| 20. Subtotal = | | | | | \$0770 | |
| 21. If "petition" box 13 above is X'd, add petition fee. \$130 | | | | | +0 | 1808 |
| 21A. If box 6 above is X'd, add Assignment recording fee \$ 40 | | | | | +0 | 8021 |
| 22. TOTAL FILING FEE = | | | | | \$770 | |

(carry forward to Item 31)

23. ☒ ATTACHED: Statement To Support Filing and Submission of Sequence Listing In Accordance with 37 C.F.R §1.821-1.825
24. ☒ Preliminary Amendment attached (to be entered after assigning Appln. No.)
25. ☐ See **NONPUBLICATION REQUEST** under Rule 213(a) attached (Pat-258)

26.

**ADDITIONAL FEE CALCULATION FOR
PRELIMINARY AMENDMENT
PER BOXES 24/25**

| | Claims remaining after amendment | Highest number previously paid for | Present Extra | Additional Fee | |
|-----|--|---|---------------------------------|----------------------|--|
| | | | | | <u>Large/Small Entity</u> <u>File Code</u> |
| 27. | Total Effective Claims * | minus ** 0 | = 0 x \$18/\$9 | = \$ 0 | (1202/2202) |
| 28. | Independent Claims * | minus *** 0 | = 0 x \$86/\$43 | = + 0 | (1201/2201) |
| 29. | If amendment enters proper multiple dependent claim(s) into this application for the first time, add (per application) \$290/\$145 | | | + 0 | (1203/2203) |
| 30. | | | ADDITIONAL FEE | \$ 0 | |
| 31. | | | plus FEE from item 22 on page 3 | + 770 | |
| 32. | | | <u>TOTAL FEE</u> | <u>\$ 770</u> | |

33. *If the entry in this space is less than a entry in the next space, the "Present Extra" result is "0"

34. **If the "Highest number previously paid for" (see item 17 above) is less than 20, write "20" in this space

35. If the "Highest number previously paid for" (see item 18 above) is less than 3, write "3" in this space

**PLEASE CHARGE
OUR DEP. ACCT.**

Our Deposit Account No. 50-2212

Our Order No.

044988

C#

0304593

M#

CHARGE STATEMENT: Upon the filing of a Declaration pursuant to Rule 60(b) or 60(d), the Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown above for which purpose a duplicate copy of this sheet is attached.

This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.

Intellectual Property Group

By Atty:

Aubrey A. Haddach
Aubrey A. Haddach

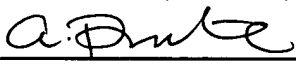
4/7/04

Reg. No. 48,374

Tel:
AAH/aar
Atty./Sec.

Fax: 858-509-4010
Tel: 858-847-4189

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|---|
| In re the Patent Application of: | Group Art Unit: Not yet assigned |
| Applicant: Pantoliano <i>et al.</i> | Examiner: Not yet assigned |
| Serial No.: Not yet assigned | <u>Certificate of Mailing Under C.F.R. §1.8</u> |
| Filed: April 7, 2004 | I hereby certify that this correspondence and all marked attachments are being deposited by Express Mail, Express Mailing Label No.: EL 989434393 US on April 7, 2004 addressed to: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. |
| Title: <i>Microplate Thermal Shift Assay Apparatus For Ligand Development And Multi-Variable Protein Chemistry Optimization</i> | By:  Abigail Rivamonte |

REQUEST TO APPROVE PROPOSED DRAWING CORRECTIONS

MAIL STOP PATENT APPLICATION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Attached are copies of three (3) sheets of drawings. Two of the sheets of drawings contain proposed corrections to Figures 25 and 41A, circled in red. In Figure 25, a diamond symbol and the text "pH 8/0.1 NaCl" is sought to be added. In Figure 41A, the legend "Control ANS/No Protein" is sought to be added. The third drawing sheet contains Figures 8A and 8B, which Applicants propose in place of original drawing Figure 8. Similar amendments were approved in the parent (Application No. 09/801,676).

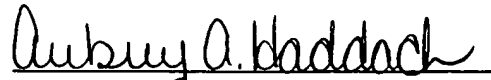
The proposed changes add no new matter to the application. Applicants request that the Examiner approve the proposed corrections. After official communication of such approval, Applicants will make the appropriate corrections and submit the formal drawings.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided. No fee is believed to be due in connection with the filing of this request. However, if any fee is

due, please charge the appropriate fee to Deposit Account No. 50-2212, Order Number 044988.030.8977.

Respectfully submitted,

Date: April 7, 2004

A handwritten signature in black ink, reading "Aubrey A. Haddach", written over a horizontal line.

Aubrey A. Haddach

Registration No. 48,374

PILLSBURY WINTHROP, LLP

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San Diego, California 92130-2092

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